

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IHN.051.WUS

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on _____

Signature _____

Typed or printed name _____

Application Number

10/561,642

Filed

April 4, 2006

First Named Inventor

NEVALAINEN

Art Unit

2451

Examiner

Hussain, I.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Erin M. Nichols/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Erin M. Nichols

Signature

Typed or printed name

☒ attorney or agent of record.
Registration number 57,125

952-854-2700

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

July 7, 2009

Date

Registration number if acting under 37 CFR 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Appellant:	Nevalainen	Examiner:	Hussain, I.
Serial No.:	10/561,642	Group Art Unit:	2451
Filed:	April 4, 2006	Docket No.:	IHN.051.WUS
Confirmation No.:	8247	Customer No.:	76385
Title:	Method and Device for Determining and Notifying Users Having Matching Preference Profiles for Accessing a Multiple Access Online Application		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being transmitted to the U.S. Patent and Trademark Office via the Office electronic filing system in accordance with 37 CFR 1.6(a)(4) on July 7, 2009.

By: /Erin M. Nichols/
Erin M. Nichols

**APPELLANT'S STATEMENT IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notice of 12 July 2005, regarding the New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal review is appropriate.

Each of the § 103(a) rejections is based at least on the teachings of WO 01/86997 to Varland (hereinafter "Varland") as modified by those of "The Bayou Architecture" by Demers *et al.* (hereinafter "Demers").

While Appellant has multiple issues for appeal, the primary purpose for submitting this particular request for review concerns omissions of essential elements required for a *prima facie* obviousness rejection. Although each of the independent claims (Claims 1, 3, 5, 10, 12, 15, 17, and 22) is rejected in the final Office Action (dated January 7, 2009) at least in view of the combination of Varland and Demers, neither Varland nor Demers (nor the additionally relied upon references) teaches or suggests certain of the claimed limitations.

The example limitations at issue for purposes of this request for review, using independent Claim 1 as an example, relate to: 1) receiving a preference profile from a mobile terminal related to at least one other user, 2) saving said received data, and 3) sending a notification to each of the mobile terminals related to determined users, where each of these operations is performed by the mobile terminal device which received the preference profile (emphasis added). To establish a *prima facie* § 103(a) rejection of at least independent Claims 1, 5, 10, 15, and 17, these limitations must be present in Varland, Demers, or the additionally relied-upon references, as the Examiner alleges.

The claimed invention is directed to a single mobile terminal device operating as a server for other mobile terminals. However, the Office Action has not identified a single device that performs each of the operations of the claimed mobile terminal. In contrast, the Office Action relies on multiple devices set forth in Varland. To illustrate this lack of correspondence, the following Chart 1 shows the different devices relied upon in Varland as corresponding to the claimed mobile terminal device of Appellant's Claim 1.

Chart 1

Appellant's Claim 1	Varland
receiving, in a mobile terminal device related to a user, a preference profile including identification data and preference data related to at least another user, from a mobile terminal related to said at least one other user	Encoded versions of the clearinghouse unit's client database are sent to the <u>operators</u> . (page 2, lines 1-2) or The operators send a position signal to the position database of the <u>clearinghouse unit</u> . (page 2, lines 9-14)
saving said received identification data and said received preference data in a user database	The service providers transfer personal information to the <u>clearinghouse unit</u> where it may be stored. (page 6, lines 19-23)
comparing, in the mobile terminal device which received the preference profile, said received preference data with the preference data contained in the user database	Clearinghouse unit 26
determining, in the mobile terminal device which received the preference profile, a plurality of users having said substantially matching preference data	Clearinghouse unit 26
sending a notification, from the mobile terminal device which received the preference profile, to each of said mobile terminals related to said determined users	The <u>operators</u> notify the first and second clients. (page 2, lines 14-22)

As may be seen in the chart, no single device has been asserted as corresponding to each of the operations performed by the claimed mobile terminal device.

Moreover, several of the asserted portions of Varland do not correspond to the claimed limitations. For example, neither the asserted operators nor the clearinghouse unit receive client database information (asserted as corresponding to the claimed preference profile) from a mobile terminal related to said at least one other user, as claimed. Rather, the citations indicate that the operators receive the information from the clearinghouse unit and the clearinghouse unit receives the position signal from the operators. Also, the asserted personal information saved by the clearinghouse unit is received from service providers, not from a mobile terminal related to said at least one other user, as claimed. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejections are improper, and Appellant accordingly requests that the rejections be reversed.

A similar error occurs in the rejection of independent Claims 3, 12, and 22. The asserted alignment of Varland to the claimed limitations relies on different devices as corresponding to the claimed server as illustrated in Chart 2 below.

Chart 2

Appellant's Claim 1	Varland
sending a preference profile including identification data and preference data of a user to a server . . . , wherein the server is a mobile terminal device with access to a multiple access online application and related to another user	Encoded versions of the clearinghouse unit's client database are sent to the <u>operators</u> . (page 2, lines 1-4) or The operators send a position signal to the position database of the <u>clearinghouse unit</u> . (page 2, lines 9-14)
receiving a notification from said server, said notification comprising an offer to get access to said multiple access online application according to said preference data, wherein said notification comprises data to enable an access of said user to said multiple access online application	The service provider receives an activation signal from the clearinghouse unit. (Claim 4) The <u>service provider</u> sends an initiation signal to the first and second clients. (Claim 4)

Notably, the only device asserted as having access to a multiple access online application (and therefore corresponding to the claimed server) is the service provider. However, the asserted alignment does not provide correspondence to sending a preference profile to a service provider. Therefore, the asserted alignment of Varland fails to correspond to each of the limitations of the independent claims.

Varland is directed to a system using an intermediary clearinghouse unit to match clients while maintaining the clients' privacy. In contrast, the claimed invention involves direct communication between mobile terminals and a server mobile terminal device. Thus, merely replacing one or all of the devices of Varland with a mobile terminal device as asserted would still fail to correspond to the claimed invention. Notably, Demers is silent with respect to comparing, matching, and sending notifications regarding preference profiles in a mobile terminal device as claimed. Since Varland does not teach the claim limitations as asserted, and none of the additionally relied upon references overcome the deficiencies in Varland, each of the § 103(a) rejections is improper. Appellant accordingly requests that each of the rejections be reversed.

It is respectfully submitted that there is an omission of an essential element needed for a *prima facie* obviousness rejection. None of the asserted references teaches or suggests at least a mobile terminal device performing each of the claimed operations. Because none of the asserted references involves or otherwise addresses a mobile terminal device as claimed, Appellant believes these claim limitations are improperly being overlooked, and consequently there is an omission of an essential element(s) required for a *prima facie* rejection.

It is Appellant's position that the Examiner's reliance on at least the combination of Varland and Demers as teaching the claimed mobile terminal device is inappropriate, as neither Varland nor Demers has been shown to address this.

Appellant believes that this statement, when viewed together with the prosecution history, sets forth clear grounds for a finding that the rejections based at least upon Varland and Demers are improper and without basis.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
Attorneys at Law
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700 (tel.)

By: /Erin M. Nichols/
Name: Erin M. Nichols
Reg. No.: 57,125